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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/787,276      | 02/25/2004  | Peter D. Brewer      | B-4712 620052-7     | 5160             |

36716 7590 09/22/2005

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EXAMINER

PHAM, THANHHA S

ART UNIT PAPER NUMBER

2813

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-23, drawn to a method for removing defects from a semiconductor surface, classified in class 438, subclass 694+.
  - II. Claims 24-32, drawn to a method for removing defective structures from an epitaxial layer, classified in class 117, subclass 98+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require thinning the coating layer to reveal portions of the defective structures without revealing portions of the surface of the epitaxial layer. The subcombination has separate utility such as removing defective structures from an epitaxial layer of any structure that is not for semiconductor surface.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. The Invention I of this application contains claims directed to the following patentably distinct species of the claimed invention:

la. Species la, claims 1-2, 3-5, 9-12 and 18-23, drawn to a method for removing defects from a semiconductor surface comprising coating the semiconductor surface and the defects with a protective layer wherein the protective layer is a photoresist layer.

lb. Species lb, claims 1-2, 6-8, 13-17 and 18-23, drawn to a method for removing defects from a semiconductor surface comprising coating the semiconductor surface and the defects with a protective layer wherein the protective layer is selected from a group comprising silicon oxide and silicon nitride.

The Invention II of this application contains claims directed to the following patentably distinct species of the claimed invention:

Ila. Species la, claims 24-26, 27-29 and 31-32, drawn to a method for removing defective structure from an epitaxial layer comprising applying a coating layer to a surface of the epitaxial layer, the coating layer coating the surface and the defective structures wherein the coating layer is a photoresist layer.

IIb. Species IIb, claims 24-26, 30 and 31-32, drawn to a method for removing defective structure from an epitaxial layer comprising applying a coating layer to a surface of the epitaxial layer, the coating layer coating the surface and the defective structures wherein the coating layer is selected from a group comprising silicon oxide and silicon nitride.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

3. A telephone call was made to Alessandro Steinfl on 09/15/2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhha Pham whose telephone number is (571) 272-1696. The examiner can normally be reached on Monday and Thursday 9:00AM - 9:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead can be reached on (571) 272-1702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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